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Alan Scott Hodes

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ALAN S. HODES

1755 POPPY AVE.

MENLO PARK, CA 94025-5737

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/788,532
Filing Date: February 27, 2004
Appellant(s): HODES, ALAN SCOTT

Alan S. Hodes
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 11/20/2007 appealing grounds of rejection set forth in the Office action mailed 04/18/2007.

(1) Real Party of Interest

A statement identifying the real party of interest is contained in the brief.

(2) Related Appeals and Interferences

The Examiner is not aware of any related appeals, interferences, or judicial proceedings, which directly affect or will be affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

There are no unentered amendments.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The Appellant's statement of the grounds of rejection to be reviewed on appeal is substantially correct. The changes are as follows:

WITHDRAWN REJECTIONS

The following grounds of rejection are not presented for review on appeal because they have been withdrawn by the examiner.

Ground I:

Claims 1, 6, 13, 14 and 21 are provisionally rejected on the ground of non-statutory obviousness-type double patenting as being unpatentable over claims 1 and 2 of co-pending Application No. 11/151,781.

Ground II:

Claims 3-4 are rejected under 35 U.S.C. 101 as being directed to non-statutory subject matter.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

2002/0111941 A1	Roux et al.	08-15-2002
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2004/0181427 A1	Stobbs et al.	09-16-2004
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6,711,585 B1	Copperman et al.	03-23-2004
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Sheremetyeva et al., "Generating Patent Claims From Interactive Input," 1996, Computing Research Laboratory, New Mexico State University & Carnegie Group, Inc., 10 Pages.

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-5, 11-14, 18-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Application Publication Number 2002/0111941 issued to Claude Roux et al. (hereinafter “Roux”) in further view of U.S. Patent Application Publication Number 2004/0181427 issued to Gregory A. Stobbs et al. (hereinafter “Stobbs”).

Claim 1:

Roux discloses a method of analysis regarding at least one patent claim, comprising:

a) determining a correspondence of the portions of the at least one patent claim to concept nodes of an ontology (*Roux: paragraph [0038], lines 7-10 and paragraph [0039] and paragraph [0040], lines 8-11 and paragraph [0041] and paragraph [0052], lines 1-4 and paragraph [0075]; It is important to note that a patent claim is simply text. So performing a scan and search on a text document is the same as performing a scan and search on a patent claim. Further note that the ‘semantic lattice’ is a conceptual graph of relationships between words that is built using a thesaurus or ontology.*);

b) determining a correspondence of the portions of at least one instance to the concept nodes of the ontology (*Roux: paragraph [0038], lines 7-10 and paragraph [0039] and paragraph [0040], lines 8-11 and paragraph [0041] and paragraph [0052], lines 1-4 and paragraph [0075]; Again note that a one ‘instance’ or embodiment is simply text. The process for steps b) and a) are identical, so the same rejection applies.*); and

c) processing the determined correspondence of the portions of the at least one patent claim and the determined correspondence of the portions of the at least one instance (*Roux: paragraph [0041] and paragraph [0042], lines 1-3 and paragraph [0043], lines 1-7*).

Roux does not explicitly disclose wherein a result of processing the determined correspondence of the portions of the at least one patent claim portions and the determined correspondence of the portions of the at least one instance includes a determination of whether the at least one instance reads on the at least one patent claim.

However, Stobbs discloses wherein a result of processing the determined correspondence of the portions of the at least one patent claim portions and the determine correspondence of the portions of the at least one instance includes a determination of whether the at least one instance reads on the at least one patent claim (*Stobbs: paragraph [0107], lines 1-12 and paragraph [0108], lines 1-8 and paragraph [0109], lines 1-10 and Abstract and Fig. 9; Note specifically the 'claim validity analysis module' 190 and also 'product coverage / infringement analysis' 188.*).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Roux with the teachings of Stobbs noted above. The skilled artisan would have been motivated to improve the teachings of Roux with the teachings of Stobbs per the above such that it is possible to discover documents, products, or product descriptions that validate, invalidate, or infringe upon a patent claim (*Stobbs: paragraph [0107], lines 1-12 and paragraph [0108], lines 1-8 and paragraph [0109], lines 1-10 and Abstract and Fig. 9*).

Claim 2:

The combination of Roux and Stobbs discloses all the elements of claim 1, as noted above, and Roux further discloses wherein:

step a) includes completing a claim record for each of the at least one patent claim under study indicating the correspondence determined in step a) (*Roux: paragraph [0040]; The claim records and instance records simply appear to be portions of claims or documents which have established a mapping to concept nodes and are then stored (Applicant's Specification paragraph [0083], lines 7-11). Furthermore, the claims and documents are simply text. Clearly the Roux reference shows storing an established mapping to a concept node (Roux: paragraph [0040]).*);

step b) includes completing an instance record for each of the at least one instance under study (*Roux: paragraph [0040]*); and

step c) includes processing the completed claim records and the completed instance records (*Roux: paragraph [0040]; Surely the process described in paragraph [0040] requires processing the mapping to the concept nodes ('claim record' or 'instance record').*).

Claim 3:

The combination of Roux and Stobbs discloses all the elements of claim 2, as noted above, and Stobbs further discloses wherein:

the claim record and the instance record are embodied in a computer-readable medium (*Roux: paragraph [0040]*); and

step c) includes a computer executing a program to process the claim record and the instance record (*Roux: paragraph [0040]*).

Claim 4:

The combination of Roux and Stobbs discloses all the element of claim 3, as noted above, and Roux further discloses wherein:

step c) further includes the computer executing a program to process an index to instance records, by concept node, based on at least one concept node indicated in at least one of the completed claim records (*Roux: paragraph [0063], lines 1-7; The Roux reference clearly discloses creating an index for records based on concept nodes. The invention set forth in claim 4 is clearly an obvious variation of the what Roux discloses in paragraph [0063].*).

Claim 5:

The combination of Roux and Stobbs disclose all the elements of claim 2, as noted above, and Roux further disclose wherein:

completing the claim record and completing the instance record includes indicating the concept node to which each portion of the corresponding claim and instance, respectively, corresponds (*Roux: paragraph [0039] and paragraph [0052]; The generation of a semantic lattice (ontology connecting concept nodes) must involve some form of indication of corresponding conceptual nodes.*),

processing the completed claim records and the completed instance records includes determining a comparison of the concept nodes indicated by claim records to concept nodes indicated by instance records (*Roux: paragraph [0043], lines 1-7*).

Claim 11:

The combination of Roux and Stobbs discloses all the elements of claim 1, as noted above, and Roux further discloses wherein:

step c) includes comparing the determined correspondence of the portions of the at least one patent claim to the determined correspondence of the portions of at least one instance (*Roux: paragraph [0041] and paragraph [0043], lines 1-7*).

Claim 12:

The combination of Roux and Stobbs discloses all the elements of claim 11, as noted above, and Roux further discloses wherein:

step c) includes processing the ontology to determine a relation between the scope of the concepts to which portions of the at least one patent claim correspond and the scope of the concepts to which respective portions of the at least one instance correspond (*Roux: paragraph [0041] and paragraph [0042], lines 1-3 and paragraph [0043], lines 1-7*).

Claim 13:

Claim 13 is rejected under the same reasons set forth in the rejection of claim 1.

Claim 14:

Claim 14 is rejected under the same reasons set forth in the rejection of claim 1.

Claim 18:

The combination of Roux and Stobbs discloses all the elements of claim 1, as noted above, and Roux further discloses wherein:

the step of determining a correspondence of the portions of the at least one patent claim to the concept nodes of an ontology includes , for each of at least one of the portions, adding to the ontology a concept node to which that portion corresponds (*Roux: paragraph [0040], lines 11-15 and paragraph [0060] and paragraph [0052]; These references clearly show the adding of a concept node to an ontology (semantic lattice).*).

Claim 19:

The combination of Roux and Stobbs discloses all the elements of claim 1, as noted above, and Roux further discloses wherein:

the step of determining a correspondence of the portions of at least one instance to the concept nodes of the ontology includes, for each of the at least one of the portions, adding to the ontology a concept node to which that portion corresponds (*Roux: paragraph [0040], lines 11-15 and paragraph [0060] and paragraph [0052]; These references clearly show the adding of a concept node to an ontology (semantic lattice).*).

Claim 20:

The combination of Roux and Stobbs discloses all the elements of claim 1, as noted above, and Roux further discloses wherein:

the step of determining a correspondence of the portions of the at least one patent claim to the concept nodes of an ontology includes, for each of the at least one of the portions (*Roux: paragraph [0038], lines 7-10 and paragraph [0039] and paragraph [0040], lines 8-11 and paragraph [0041] and paragraph [0052], lines 1-4 and paragraph [0075]; It is important to note that a patent claim is simply text. So performing a scan and search on a text document is the same as performing a scan and search on a patent claim. Further note that the 'semantic lattice' is a conceptual graph of relationships between words that is built using a thesaurus or ontology.*), adding to the ontology a concept node which that portions corresponds (*Roux: paragraph [0040], lines 11-15 and paragraph [0060] and paragraph [0052]; These references clearly show the adding of a concept node to an ontology (semantic lattice).*); and

the step of determining a correspondence of the portions of at least one instance to the concept nodes of the ontology includes, for each of the at least one of the portions, adding to the ontology a concept node to which that portion corresponds (*Roux: paragraph [0040], lines 11-15 and paragraph [0060] and paragraph [0052]; These references clearly show the adding of a concept node to an ontology (semantic lattice).*).

Claim 21:

Claim 21 is rejected under the same reasons set forth in the rejection of claim 1.

Claim 22:

The combination of Roux and Stobbs discloses all the elements of claim 21, as noted above, and Roux further discloses a system comprising:

ontology storage holding the ontology (*Roux: Fig. 1, 103 and paragraph [0039] and paragraph [0052]; The semantic lattice is composed of ontologies.*).

Claim 23:

The combination of Roux and Stobbs discloses all the elements of claim 21, as noted above, and Roux further discloses a system comprising:

document storage, holding at least one document, wherein the at least one document embodies the plurality of instances (*Roux: paragraph [0002]*);

wherein each instance record includes at least one link record configured to hold a link to the separate one of the plurality of instances embodied in the at least one document (*Roux: paragraph [0051] and paragraph [0052]; Note specifically that each concept is connected (linked to) other concepts through relation nodes.*).

Claim 24:

The combination of Roux and Stobbs discloses all the elements of claim 23, as noted above, and Roux further discloses wherein:

the at least one link included which each instance record is configured to hold includes a plurality of links, wherein each link is a link to a separate portion of the instance with which the instance record is associated (*Roux: paragraph [0051] and paragraph [0052]; Note specifically that each*

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concept is connected (linked to) other concepts through relation nodes. If there is a plurality of relations, there would be a plurality of links or connections.).

Claim 25:

The combination of Roux and Stobbs discloses all the elements of claim 23, as noted above, and Roux further discloses a system comprising:

an instance record index comparing a plurality of entries (*Roux: paragraph [0038]; The use of indexes for records in a database is well known in the art.*),

wherein, each entry of the instance record index

corresponds to a separate concept node in the ontology, and is configured to hold an indication of the instance records holding an indication of the concept node to which that entry of the instance record corresponds (*Roux: paragraph [0038], lines 7-10*).

Claims 6-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Roux in view of Stobbs and further in view of U.S. Patent Number 6,711,585 issued to Max Copperman et al. (hereinafter “Copperman”).

Claim 6:

The combination of Roux and Stobbs discloses all the elements of claim 5, as noted above, but the previously mentioned combination does not explicitly disclose wherein:

determining a comparison includes determining whether there is one to one correspondence between concept nodes in claim records and concept nodes in instance records.

However, Copperman discloses wherein determining a comparison includes determining whether there is a one to one correspondence between concept nodes in claim records and concept nodes in instance records (*Copperman: column 15, lines 8-11*).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the previously mentioned combination with the teachings of Copperman noted above. The skilled artisan would have been motivated to improve the previously mentioned combination per the above such that the use of concept nodes in a document retrieval system provides for faster and more relevant responses than a content-based retrieval system (*Copperman: column 2, lines 53-59*).

Claim 7:

The combination of Roux, Stobbs, and Copperman discloses all the elements of claim 6, as noted above, and Roux further discloses wherein:

the comparison means is among the concept nodes indicated by each of a plurality of ones of the instance records, respectively, and the concept nodes indicated by one claim record (*Roux: paragraph [0041] and paragraph [0043], lines 1-7 and paragraph [0052]*).

Claim 8:

The combination of Roux, Stobbs, and Copperman discloses all the elements of claim 7, as noted above, and Roux further discloses wherein:

the comparison includes considering the scope of the concepts corresponding to the concept nodes indicated by each instance record, respectively, relative to the scope of the concepts corresponding to the concept nodes indicated by the one claim record (*Roux: paragraph [0041] and paragraph [0043], lines 1-7 and paragraph [0052]*).

Claim 9:

The combination of Roux, Stobbs, and Copperman discloses all the elements of claim 6, as noted above, and Roux further discloses wherein:

the comparison is among the concept nodes indicated by each of a plurality of ones of the claim records, respectively, and the concept nodes indicated by one instance record (*Roux: paragraph [0041] and paragraph [0043], lines 1-7 and paragraph [0052]*).

Claim 10:

The combination of Roux, Stobbs, and Copperman discloses all the elements of claim 6, as noted above, and Roux further discloses wherein:

the comparison is among the concept nodes indicated by each of a plurality of ones of the claim records, respectively, and the concept nodes indicted by one instance record (*Roux: paragraph [0041] and paragraph [0043], lines 1-7 and paragraph [0052]*).

Claims 15-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Roux in view of Stobbs and further in view of Non-Patent Literature Article titled “Generating Patent Claims From Interactive Input” issued to Svetlana Sheremetyeva et al. (hereinafter “Sheremetyeva”).

Claim 15:

The combination of Roux and Stobbs discloses all the element of claim 14, as noted above, and Roux further discloses a method comprising:

determining a correspondence of the portions of an embodiment to the concept nodes of the ontology (*Roux: paragraph [0038], lines 7-10 and paragraph [0039] and paragraph [0040], lines 8-11 and*

paragraph [0041] and paragraph [0052], lines 1-4 and paragraph [0075]; It is important to note that a description of an embodiment of a invention is simply text. So performing a scan and search on a text document is the same as performing a scan and search on a description of an embodiment of an invention. Further note that the 'semantic lattice' is a conceptual graph of relationships between words that is built using a thesaurus or ontology.).

The previously mentioned combination does not explicitly disclose processing the determined correspondence of the embodiment portions and formulating the at least one patent claim based at least in part thereon.

However, Sheremetyeva discloses processing the determined correspondence of the embodiment portions and formulating the at least one patent claim based at least in part thereon (*Sheremetyeva: Abstract, lines 4-5 and page 2, left column, lines 34-37 and page 2, right column, lines 7-10, 14-17, 23-29 and page 3, Fig. 2, 10-14*).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the previously mentioned combination with the teachings of Sheremetyeva noted above. The skilled artisan would have been motivated to improve the previously mentioned combination per the above such that the system and method aid an inventor in composing patent claims (*Sheremetyeva: page 2, left column, lines 34-37*).

Claim 16:

The combination of Roux, Stobbs, and Sheremetyeva discloses all the elements of claim 15, as noted above, and Sheremetyeva further discloses:

the formulated at least one patent claim is a first formulated at least one patent claim (*Sheremetyeva: Abstract, lines 4-5 and page 2, left column, lines 34-37 and page 2, right column, lines 7-10, 14-17,*

23-29 and page 3, Fig. 2, 10-14; The reference clearly shows formulating a patent claim. Surely one of the formulated claims has to be a first claim.); and

the method further comprises

formulating a second at least one patent claim (*Sheremetyeva: Abstract, lines 4-5 and page 2, left column, lines 34-37 and page 2, right column, lines 7-10, 14-17, 23-29 and page 3, Fig. 2, 10-14; If one can generate a first patent claim, one can generate a second patent claim.*).

Neither Roux nor Sheremetyeva explicitly discloses wherein the analysis of the patent claim consists at least in part on the determination of whether the at least one prior art instance renders the first at least one patent claim unpatentable.

However, Stobbs discloses wherein the patent claim analysis consists at least in part on the determination of whether the at least one prior art instance renders the first at least one patent claim unpatentable (*Stobbs: Stobbs: paragraph [0107], lines 1-12 and paragraph [0108], lines 1-8 and paragraph [0109], lines 1-10 and Abstract and Fig. 9.*).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the previously mentioned combination with the further teachings of Stobbs noted above. The skilled artisan would have been motivated to improve previously mentioned combination with the further teachings of Stobbs per the above such that it is possible to discover and consider documents, products, or product descriptions that validate, invalidate, or infringe upon a patent claim (*Stobbs: paragraph [0107], lines 1-12 and paragraph [0108], lines 1-8 and paragraph [0109], lines 1-10 and Abstract and Fig. 9.*).

Claim 17:

The combination of Roux and Stobbs discloses all the elements of claim 14, as noted above, and Roux further discloses:

determining a correspondence of the portions of an embodiment to the concepts nodes of the ontology (*Roux: paragraph [0038], lines 7-10 and paragraph [0039] and paragraph [0040], lines 8-11 and paragraph [0041] and paragraph [0052], lines 1-4 and paragraph [0075]; It is important to note that a description of an embodiment of a invention is simply text. So performing a scan and search on a text document is the same as performing a scan and search on a description of an embodiment of an invention. Further note that the 'semantic lattice' is a conceptual graph of relationships between words that is built using a thesaurus or ontology.*).

Roux does not explicitly disclose wherein the correspondence of at least one prior art instance is considered in the analysis of a patent claim. However, Stobbs discloses wherein the correspondence of at least one prior art instance is considered in the analysis of a patent claim (*Stobbs: paragraph [0107], lines 1-12 and paragraph [0108], lines 1-8 and paragraph [0109], lines 1-10 and Abstract and Fig. 9*).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Roux with the teachings of Stobbs noted above. The skilled artisan would have been motivated to improve the teachings of Roux with the teachings of Stobbs per the above such that it is possible to discover and consider documents, products, or product descriptions that validate, invalidate, or infringe upon a patent claim (*Stobbs: paragraph [0107], lines 1-12 and paragraph [0108], lines 1-8 and paragraph [0109], lines 1-10 and Abstract and Fig. 9*).

Neither Roux nor Stobbs discloses processing the determined correspondence of the embodiment portions and formulating at least one patent claim based at least thereon. However,

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Sheremetyeva discloses processing the determined correspondence of the embodiment portions and formulating at least one patent claim based at least thereon (*Sheremetyeva: Abstract, lines 4-5 and page 2, left column, lines 34-37 and page 2, right column, lines 7-10, 14-17, 23-29 and page 3, Fig. 2, 10-14*).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the previously mentioned combination with the teachings of Sheremetyeva noted above. The skilled artisan would have been motivated to improve the previously mentioned combination per the above such that the system and method aid an inventor in composing patent claims (*Sheremetyeva: page 2, left column, lines 34-37*).

(10) Response to Arguments

Appellant Argues:

In contending that Roux discloses the subject matter of steps a), b) and c) of claim 1, the Examiner has contended that "It is important to note that a patent claim is simply text." See Office Action dated April 18, 2007, page 4. Furthermore, the Examiner has also stated, at pages 17-18 of the Office Action:

"It is the Examiner's position that an operation that can be performed on one type of text document can be performed on any type of text document. It is a fact that a patent claim is simply text. This leads to the conclusion that any operation that can be performed on a text document can also be performed on the text of a patent claim."

More generally, then, the Examiner is contending that disclosure of a genus (text) anticipates (i.e., "is simply") a species (claims). This contention is clear error and, therefore, all the prior art based rejections must fail, since all the prior art based rejections rely on this contention.

Applicant respectfully refers the Examiner to MPEP 2131.02, which is entitled "Genus-Species Situations" and sets forth a good discussion of the law in this area.

Examiner Responds:

Examiner is not persuaded. First, the Examiner respectfully points out that the Examiner did not reject claim 1 as anticipated under any subsection of 35 U.S.C. 102. However, the Appellant refers to sections of the MPEP, and bases his argument, on an issue (Genus-

Species Situations) that is commonly associated with anticipation rejections under 35 U.S.C 102 (see MPEP 2131 – 2131.02).

Since the claims were actually rejected under 35 U.S.C. 103(a) as being obvious over the prior art of record, Appellants arguments against whether the cited prior art "anticipates" the claimed invention are indeed irrelevant. Therefore, the Appellant's arguments set forth above are effectively rendered moot.

But, for arguments sake, the Examiner has decided to briefly touch upon the issue of patent claims as text. There is no specific feature of a patent claim that differentiates itself from plain text. It is the Examiner's position that a computer that performs a specific operation on a text document can perform the same operation on a patent claim. In fact, the Examiner sets forth that a computer performing the operation would not even know the difference between plain text and a patent claim. They are in fact interchangeable as far as a computer program operating on the text of a text document or a patent claim. In other words, the Examiner asserts that the results yielded from applying the method and apparatus of Roux to Patent claims would indeed be predictable. As a result, the Appellant's claim limitations are rendered as being an obvious variation of the prior art of record.

And finally, it is noted that the Appellant has failed to point out any functional difference in the operation of the Roux reference and the Appellant's claimed invention. The only argument set forth from the Appellant (in a broad sense) is that a computer program would handle a patent claim differently than plain text. This is simply the Appellant's own

opinion. And it is noted that the Appellant has provided no evidence to support such an opinion.

Due to a lack of persuasive arguments and since it appears that each and every element of the Appellant's claimed invention is either disclosed or suggested by the prior art of record, the claims remain rejected under the reasons set forth in the preceding office action.

Appellant Argues:

The Examiner also seems to import an improper "obvious to try" assertion with regard to the argument that "any operation that can be performed on a text document can also be performed on the text of a patent claim.

Examiner Responds:

Examiner is not persuaded. The Examiner did not give a rejection under 35 U.S.C. 103(a) using the "obvious to try" rationale to combine the prior art references. The Examiner rejected the claims under 35 U.S.C. 103(a) using the Teaching-Suggestion-Motivation rationale for combining prior art references. Therefore, it appears that the arguments submitted above are indeed irrelevant.

Due to a lack of persuasive arguments and since it appears that each and every element of the Appellant's claimed invention is either disclosed or suggested by the prior art of record, the claims remain rejected under the reasons set forth in the preceding office action.

Appellant Argues:

The Examiner simply has not made a prima facie case that the Roux reference discloses processing a "claim".

The Examiner contends that it is the Applicant's burden to rebut the contention "with evidence or support." See pp. 17-18 of the Office Action mailed April 18, 2007, where the Examiner says that "Applicant did not provide

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any support for the allegation that the text of patent claims is different from the text of ordinary documents." It is the Examiner's initial burden to set forth a proper *prima facie* case, and this he did not do.

Examiner Responds:

Examiner is not persuaded. The Examiner did in fact set forth a *prima facie* case. One element of the Examiner's *prima facie* case was that a patent claim is handled the same as a text document in a computer system. Furthermore, another element of the Examiner's *prima facie* case is that the Appellant's claimed invention is an obvious variation of the combination of prior art references cited above. For a complete and accurate account of the Examiner's *prima facie* case, the Examiner directs the Appellant to the Examiner's office actions dated 09/25/2006 and 04/18/2007.

It is well known in patent law that once the Examiner presents the Applicant with a *prima facie* case, the burden shifts to the Applicant to come forward with arguments and/or evidence to rebut the *prima facie* case (MPEP 2145). Since the Examiner has made a *prima facie* case, it is the Appellant's burden to show distinctly and specifically where errors occurred in the Examiner's office action (37 C.F.R. 1.111b). So the burden has now been shifted to the Appellant to prove that a patent claim is not simply text. And to date, the Appellant has failed to provide any evidence that supports the Appellant's opinion that a patent claim must be handled differently than plain text in a computer system.

Due to a lack of persuasive arguments and since it appears that each and every element of the Appellant's claimed invention is either disclosed or suggested by the prior art of record, the claims remain rejected under the reasons set forth in the preceding office action.

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Appellant Argues:

With regards to Stobbs, the Examiner is in clear error in contending, at page 4 of the Office Action mailed April 18, 2007, that "Stobbs discloses wherein a result of processing the determined correspondence of the portions of the at least one patent claim portions and the determined correspondence of the portions of the at least one instance includes a determination of whether the at least one instance reads on the at least one patent claim."

Examiner Responds:

Examiner is not persuaded. Cited portions of the Stobbs reference are now reproduced below for convenience.

[0108] Internet usage engine 182 includes the additional functionality of searching Internet web pages that are relevant for infringement analysis and validity analysis. Internet usage engine 182 performs product coverage and infringement analysis via module 188. Module 188 searches for Internet web pages that contain product descriptions that match or are significantly similar to the claim linguistic results.

[0109] Internet usage engine 182 includes a claim validity analysis module 190. Module 190 uses Internet search engine 186 to automatically search the Internet for content that matches or are significantly similar to the linguistic results of the patent claims at issue from the aforementioned linguistics engines. Preferably, patent priority data, such as patent filing date or foreign filing priority date, are used to focus the Internet searching. Examples of Internet search engines include, but are not limited to, the Internet search engine provided by AltaVista.

Note specifically the claim validity analysis module and infringement analysis.

Furthermore, note how Stobbs "searches for Internet web pages that contain product descriptions that **match** or are **significantly similar to** the claim linguistic results." The product descriptions (portion of at least one instance) and claim linguistic results (portion of at least one patent claim) are compared to determine a match or similarity level (determined correspondence). And this is done to determine if the product description (portion of at least one instance) reads on, or infringes, a patent claim.

Since it appears that each and every element of Appellant's claimed invention is either disclosed or suggested by the prior art of record, the claims remain rejected under the reasons set forth in the preceding office action.

Appellant Argues:

Furthermore, it is notable that not only is no ontology involved but, further, Stobbs does not even disclose processing a "determined correspondence" of anything as contended by the Examiner.

Examiner Responds:

Examiner is not persuaded. First, there is no 'ontology' explicitly mentioned in the particular claim limitation the Appellant is arguing here. The other portions of claim 1 explicitly mentioning an ontology are disclosed by the Roux reference.

And second, as noted above, the product descriptions (portion of at least one instance) and claim linguistic results (portion of at least one patent claim) are compared to determine a match or similarity level (determined correspondence). The determined match or similarity level, as disclosed in at least Stobbs paragraphs [0108] and [0109], is the determined correspondence.

Since it appears that each and every element of the Appellant's claimed invention is either disclosed or suggested by the prior art of record, the claims remain rejected under the reasons set forth in the preceding office action.

Appellant Argues:

Applicant has pointed out that “claim records” are mentioned nowhere in Copperman. The Examiner’s response, at page 21 of the Office Action mailed April 18, 2007, completely ignores Applicant’s assertion with regard to “claim records”.

However, the disclosure of mapping text to concept nodes (albeit, based on a classification determined for the text) is simply not the same as determining whether there is a one-to-one correspondence between concept nodes (remember, plural) of a claim record and concept nodes (again, plural) in instance records, which is what would typically be required in making determinations of unpatentability, invalidity, and/or infringement. The cited portion of Copperman does not appear to disclose (or even suggest) such a feature.

Examiner Responds:

Examiner is not persuaded. First, the Examiner did not ignore any limitation of the Appellant’s claimed invention. Each and every limitation was examined and given an appropriate weight of importance.

With respect to the Appellant’s specification, it is important to note that no explicit and deliberate definition is given for either an instance, instance record, or a claim record. What appears to be given are examples as to what may constitute an instance or instance record and then it appears to be understood that a claim record is a type of instance record. Since no explicit and deliberate definition of either an instance, instance record, or a claim record is provided by the Appellant, it is important to note that the Examiner is permitted to give the claim limitations their broadest reasonable interpretation.

As best the Examiner can ascertain, it can reasonably be interpreted from the Appellant’s specification that any document can be an instance (*Appellant’s Specification: paragraph [0077], lines 9-11 and paragraph [0078], lines 2-8; Note that all references made to Appellant’s specification are references made to the published version of Appellant’s specification US PGPub 2005/0144177.*), an instance record is simply a means to represent an instance (*Appellant’s Specification: paragraph [0078]; Note that instance record stores*

information about an instance (document) such as a document id.), and finally the instance record is then mapped to concept nodes in some form of a taxonomy or ontology (Appellant's Specification: [0079]).

Also, it appears that Copperman discloses an instance (*Copperman: column 5, lines 20-26*), an instance record to represent the instance (*Copperman: column 5, lines 20-26 and column 6, lines 32-34*), and finally mapping the instance record to the concept nodes of a taxonomy or ontology (*Copperman: column 6, lines 46-54*).

In light of the above comments, it is clear that Copperman discloses at least an instance record. The only apparent distinction between a claim record and an instance record is that the claim record represents a patent claim, while the instance record is directed to a text document. However, as noted above, it is the Examiner's position that this apparent difference is not patentably distinct from the prior art. A patent claim is simply text. Since, Copperman discloses an instance record, as shown above, Copperman also discloses the equivalent of a claim record (*See explanations above for a further clarification as to why a patent claim and text document are not patentably distinct.*).

The remainder of the Appellant's arguments assert that the prior art of record fails to disclose determining whether there is a one-to-one correspondence between concept nodes.

And again, the Examiner is not persuaded. The text of Copperman recites:

In one embodiment, classifications used by the text classifiers correspond one-to-one with concept nodes within topic taxonomies.

From the portion of the Copperman reference cited above, it is clear that only a one-to-one mapping between the text being classified and concept nodes in a taxonomy is permitted. So, via the contrapositive, it follows that if the mapping is not permitted, then the mapping is not one-to-one. For example, the embodiment discussed above would not allow a mapping of two-to-one, three-to-one, or many-to-one. Therefore, it follows that the Copperman reference must determine if a particular mapping is one-to-one in order to disallow any mapping of text being classified to concept nodes wherein the mapping is not one-to-one.

Since it appears that each and every element of the Appellant's claimed invention is either disclosed or suggested by the prior art of record, the claims remain rejected under the reasons set forth in the preceding office action.

Appellant Argues:

Furthermore, the Examiner notes at page 13 of the Office Action mailed April 18, 2007: "It is important to note that a description of an embodiment of an invention is simply text." Like the Examiner's statement that "a claim is simply text," this statement regarding an "embodiment of an invention" being simply text is unsupported and improper.

Examiner Responds:

Examiner is not persuaded. The Examiner has addressed the Appellant's arguments with respect to patent claims allegedly differing from text documents in a preceding portion of this office action. The same type of reasoning applies to support the Examiner's statements that a "description of an embodiment" of an invention is simply text. The fact that a "description of an embodiment" is text describing an invention in a patent application does not change how a computer would process such a text description.

Due to a lack of persuasive arguments and since it appears that each and every element of the Appellant's claimed invention is either disclosed or suggested by the prior art of record, the claims remain rejected under the reasons set forth in the preceding office action.

Appellant Argues:

Still further, with respect to Sheremetyeva, the Examiner contends that Sheremetyeva discloses processing the determined correspondence of the embodiment portions and formulating the at least one patent claim based at least in part thereon.

At best, Sheremetyeva elicits from an inventor a correspondence of claim elements to a conceptual schema.

Examiner Responds:

Examiner is not persuaded. Sheremetyeva discloses processing the determined correspondence of the embodiment portions and formulating the at least one patent claim based at least in part thereon (*Sheremetyeva: Abstract, lines 4-5 and page 2, left column, lines 34-37 and page 2, right column, lines 7-10, 14-17, 23-29 and page 3, Fig. 2, 10-14*).

First, the Appellant appears to admit that Sheremetyeva discloses at least "processing the determined correspondence of the embodiment portions" in stating that Sheremetyeva elicits from an inventor a correspondence of claim elements to a conceptual schema. The claim elements inputted by the inventor are interpreted as "embodiment portions". The inventor then inputs these embodiment portions, a computer processes them, and the computer outputs a patent claim. Clearly this process described here discloses at least "processing the determined correspondence of the embodiment portions."

And finally, the Examiner points out that it appears the Appellant has even admitted that Sheremetyeva automatically generates a patent claim (*see Appellant's Specification: paragraph*

[0013], lines 1-7; This paragraph citation is taken from the published version of Appellant's specification, US PGPub 2005/0144177. Note specifically at least the portion which recites, "There has been research into tools that in some sense automatically generate patent claim text." This portion of the Appellant's specification is written to describe the Sheremetyeva reference. Clearly this shows that the Appellant is admitting the fact that Sheremetyeva automatically generates (formulates) a patent claim.).

Since it appears that each and every element of the Appellant's claimed invention is either disclosed or suggested by the prior art of record, the claims remain rejected under the reasons set forth in the preceding office action.

Appellant Argues:

On the contrary, according to claim 15, the formulated at least one patent claim is one that can then be tested against the prior art (see text of claim 14). Therefore, not only does the combination of Roux, Stobbs, and Sheremetyeva fail to yield the subject matter of claim 15 but, also, it would not have been obvious to combine the references as the Examiner contends.

Examiner Responds:

Examiner is not persuaded. In response to Appellant's argument that the references fail to show certain features of Appellant's invention, it is noted that the features upon which Appellant relies (i.e., "the formulated at least one patent claim is one that can then be tested against the prior art") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

The arguments set forth above are rendered moot because the limitations that the Appellant argues are simply not in the claims. There are sections of claim 14 (from which claim 15 depends) that are related to comparing a patent claim to the prior art (these limitations are

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disclosed by Stobbs), however, the patent claim being compared to the prior art is not the newly formulated claim. This is clearly seen because the newly formulated claim is not generated until the last step of the method set forth in the claim 15. Nowhere, in claim 15, is there a limitation that requires comparing or 'testing' the newly formulated claim against the prior art.

Since it appears that each and every element of the Appellant's claimed invention is either disclosed or suggested by the prior art of record, the claims remain rejected under the reasons set forth in the preceding office action.

Appellant Argues:

The Examiner is not free to ignore recitations in claim 16. In fact, as the Examiner concedes, Sheremetyeva does not even disclose analyzing the patent claim to determine whether it is unpatentable. Given that, it is illogical to contend that Sheremetyeva discloses formulating "a second patent claim" based on a determination of whether a first claim is unpatentable.

Examiner Responds:

Examiner is not persuaded. First, the Examiner did not ignore any limitation of the Appellant's claimed invention. Each and every limitation was examined and given an appropriate weight of importance.

The Examiner again reminds the Appellant that the rejections given were rejections under 35 U.S.C. 103(a). A rejection under 35 U.S.C. 103(a) does not mean that a single prior art reference 'anticipates' each and every limitation of the Appellant's claims. A claim rejected under 35 U.S.C. 103(a) is a claim which is simply an obvious variation of the prior art of record. A claim rejected under 35 U.S.C. 103(a) is typically rejected in view of a combination of two or more references.

First, the Examiner points out that Sheremetyeva clearly discloses formulating a patent claim (*Sheremetyeva: Abstract, lines 4-5 and page 2, left column, lines 34-37 and page 2, right column, lines 7-10, 14-17, 23-29 and page 3, Fig. 2, 10-14*). Furthermore, the Examiner points out that the courts have clearly held that it is not invention to simply duplicate or repeat claim limitations that are recited in the prior art (*In re Harza*, 274 F.2d 669, 124 USPQ 378 (CCPA 1960)). Since the courts have held that it is not invention to simply duplicate or repeat claim limitations, the Examiner concluded that simply repeating steps of generating a patent claim would have been obvious to one of ordinary skill in the art.

Second, the Examiner acknowledges that Sheremetyeva does not disclose analyzing the patent claim to determine whether the patent claim is patentable. However, the Stobbs reference discloses analyzing the patent claim to determine whether the patent claim is patentable (*Stobbs: paragraph [0107], lines 1-12 and paragraph [0018], lines 1-8 and paragraph [0109], lines 1-10 and Abstract and Fig. 9*).

Therefore, while each and every limitation of the Appellant's claimed invention may not be anticipated by any single reference in the prior art, the Examiner asserts that the Appellant's claimed invention is nothing more than an obvious variation of the combination of Roux, Stobbs, and Sheremetyeva.

Since it appears that each and every element of the Appellant's claimed invention is either disclosed or suggested by the prior art of record, the claims remain rejected under the reasons set forth in the preceding office action.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the Examiner in the Related Appeals and Interferences section of this Examiner's Answer.

(12) Conclusion

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Patrick A. Darno/

Examiner, Art Unit 2163

Conferees:

Don Wong

/don wong/

Supervisory Patent Examiner, Art Unit 2163

/Tim T. Vo/

Supervisory Patent Examiner, Art Unit 2168

Tim Vo